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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Patent application of
Frank D'Aguanno

Serial No.: 09/676,627 ✓

Filed: October 2, 2000

For: METHOD AND APPARATUS FOR
REMOVING A GOLF CLUB HEAD
FROM A GOLF CLUB SHAFT

Group Art Unit: 3726

Examiner: S. Blount

Commissioner of Patents and Trademarks
Washington, D.C. 20231

RESPONSE TO RESTRICTION REQUIREMENT

I. INTRODUCTION, TRAVERSE AND PROVISIONAL ELECTION

This is submitted in response to an office action having no paper designation number but dated 10 January 2002 wherein the examiner required restriction of the subject matter disclosed in the above-referenced patent application. Applicant, through his undersigned attorney, hereby traverses the restriction requirement in all of its respects, requests reconsideration and withdrawal of the requirement for restriction and further requests a prompt and thorough examination of all of the claims pending in the application, on their merits.

Without prejudice to the foregoing traverse and without prejudice to Applicant's right to petition against the restriction requirement, in compliance with the requirement set forth in the official action, Applicant provisionally elects the

claims of Group II, namely claims 3-12, which the Examiner has characterized as being directed to apparatus.

II. ARGUMENT

Restriction under 35 U.S.C. 121 and 37 C.F.R. 1.141(a) is proper only if "two or more **independent and distinct** inventions are claimed in one application."¹ Restriction by the Commissioner regarding a patent application is permissible; restriction is never required on the part of the Commissioner.²

Restriction is discretionary with the examiner and must be evaluated on a case-by-case basis. These are two basic reasons for requiring division of allegedly "independent" and "distinct" inventions present in a single application: The governmental interest in obtaining proper³ revenue from filing and issue fees for each application and, the interest in maintaining the integrity of the classification system for examining applications. Ex parte Yale, 1869 C.T. 110 (Comm'r.Pat. 1869). These governmental interests must be weighed against the standards set forth in the applicable law, the stated regulations and the underlying policies, as well as against a particular applicant's interests, in order to ensure a just result.

¹ The Commissioner interprets this requirement as authorizing restriction if the inventions are independent or distinct.

² "If two or more independent and distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions..." 35 U.S.C. 121.

³ As discussed below, "proper revenue" does not mean as much revenue as possible by issuing improper division or restriction requirements; rather, "proper revenue" means just compensation for examining a patent application with respect to each truly independent and distinct invention.

A. The Examiner Has Failed To Meet His Burden To Show That The Claims Constitute Independent And Distinct Inventions

The terms "independent" and "distinct" have separate and different meanings. M.P.E.P. 802.01. As used in 35 U.S.C. 121, an "independent" invention means an invention which is "not dependent"; this means "that there is no disclosed relationship between the two (2) or more subjects disclosed, that is, they are unconnected in design, operation or effect." M.P.E.P. 802.01, ¶ 6. A product and a method practiced by the product when operated are, by definition, dependent - - there is an intimate relationship between the design and operation of a product and the method practiced by that product when it operates. M.P.E.P. 802.01.

Inventions are distinct if they are both (1) capable of separate manufacture, use, or sale as claimed and (2) patentable over each other. M.P.E.P. 802.01 ¶7. The inventions defined by the two (2) claim groups posited by the examiner cannot be considered to be distinct. A product and the method

⁴Assuming two claimed inventions are distinct in this sense, then restriction will in fact be required if, but only if, one or more of the following are present: (1) separate classifications, (2) separate status in the art, and (3) different fields of search. M.P.E.P. §808.02.

practiced during its operation cannot be the subject of separate manufacture or use. Similarly, a product and the method practiced by operation of the product, which is the characterization the examiner has used in segregating the claims into two (2) groups, are likely not patentable one over another. This being the case, the claimed groups of inventions in the instant application are not distinct, just as they are not dependent.

Every requirement to restrict has two aspects: The reason(s) why the inventions as claimed are either independent or distinct; and, the reason(s) for insisting upon restriction therebetween." M.P.E.P. 808. This two-prong analysis was adopted by the Patent Office in 1975. See Notice of April 9, 1975, 934 O.G. 450.

In this case, the Examiner has classified the claims of Group I as "drawn to a method", classified in class 29, subclass 426.1" and the claims of Group II as "drawn to apparatus, classified in Class 269." However, a showing of a separate Patent and Trademark Office classification for the respective groups of claims or inventions in question is not conclusive on the issue of restriction. Application of Young, 173 F.2d 239, 81 USPQ 139.

Having classified the claims into two different statutory categories, the Examiner then applied M.P.E.P. § 806.05(e) to determine that the claims of Group I and Group II purportedly constitute distinct inventions. M.P.E.P. § 806.05(e) provides that

Process and apparatus for its practice can be shown to be distinct inventions, if either or both of the following can be shown:
(A) that the process as claimed can be practiced by another materially different apparatus or by hand; or (B) that the apparatus

as claimed can be used to practice another and materially different process.

The examiner has reasoned that "inventions I and II are related as process and apparatus for its practice. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process as claimed can be practiced with another materially different apparatus or by hand (2) the apparatus as claimed can be used in another and materially different process (M.P.E.P. 806.05(e)). In this case, apparatus can be used to remove golf club heads wherein sufficient force is applied by the apparatus that the head of the gold club does not need to be heated."

M.P.E.P. 806.05(e) explicitly states that "the burden is on the examiner to provide reasonable examples that recite material differences." In this case, the examiner has not provided a reasonable example to document or support the examiner's position. It is not reasonable to speculate that the apparatus could be used to remove golf club heads with sufficient force being applied by the apparatus such that the head of the golf club does not need to be heated. Applying such force to a golf club and particularly to a golf club head would crack the head. The whole reason for heat is to allow the head to be removed easily from the shaft without application of undue force to the hollow, brittle cast metal or graphite or ceramic head. Without the application of heat to soften the epoxy seal between the head and the shaft, the level of force required to separate the head from the shaft is such that the head will break before the epoxy joint, which secures the head to the shaft, breaks. Accordingly, the examiner's speculated method of separating the head from the shaft solely by application of brute force

is not a reasonable, practical or workable example. In light of this, the examiner should reconsider the examiner's position regarding the alleged distinctiveness of the claims of the two groups and should withdraw the extent restriction requirement.

Furthermore, the M.P.E.P. makes it crystal clear that before restriction can be required, there must be a showing that the inventions, each of which is defined by one or more claims, must be both "independent" and "distinct" from one another. In the instant case, no such showing has been made by the Examiner.

A showing that two inventions are "distinct", as the examiner purports to have made in the Official Action, does not obviate the requirement to also make a showing that the inventions are "independent." The inventions described by Applicant are not independent. To be independent, inventions must have

no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation or effect. M.P.E.P. 802.01.

The very language of the claims at issue reveals a clear interconnection and design, operation and effect between the apparatus claims and the method claims.

Even if two patent application claims are patentably distinct from one another, this does not ipso facto mean that restriction should be required. There are two criteria which must exist in order that a requirement for restriction be proper as between patentably distinct inventions: First, the inventions must be independent or distinct as claimed; second, there must be a serious burden on

the examiner if restriction is not required. M.P.E.P. 803. If the search and examination of the an entire application can be made without serious burden, the examiner **must** examine the application on its merits, in its entirety, even though the application includes claims to distinct or independent inventions. M.P.E.P. 803.

**B. Practical And Equitable Considerations Mandate
Review Of Applicant's Claims As A Single Application**

A close examination of the practical and equitable considerations surrounding the present case compels withdrawal of the examiner's restriction requirement and requires examination of all the claims presented by Applicant in a single patent application.

1. Scope Of Search

The salient consideration for insisting upon restriction and determining the propriety of a restriction requirement is the scope of the examiner's search for prior art. Applicant is entitled to a full and thorough search of the prior art as a consequence of having filed his application and having paid the statutory application fee. 35 U.S.C. 131.

Restriction is proper only where the examiner would be unduly burdened by searching numerous, unrelated inventions or technologies. Thus, the scope of a search for related inventions, even though burdensome, cannot justify restriction of the related inventions. Further, even if an application includes claims to unrelated inventions, i.e., distinct and independent, the examiner **must** examine the application on its merits, in its entirety, if the search and examination

of the entire patent application can be made without a serious burden on the examiner. M.P.E.P. 803.

The examiner's instructional guidelines for performing such a search for any application are set forth in the M.P.E.P. The guidelines compel the examiner to search in classes and subclasses in which independent and distinct (as defined by the M.P.E.P.) inventions would be classified. For example, section 904.01(c) recites:

"Not only must the art be searched with which the invention claimed is classifiable, but also all analogous arts **regardless of where classified**. The determination of when arts are analogous is at times difficult. It depends upon the necessary essential function or utility of the subject matter covered by the claims, and not upon what it is called. (emphasis added).

Section 904.01(d) recites:

A proper field of search includes the subclass in which the claimed subject matter of an application would be properly classified.

In outlining a field of search the examiner should note every class and subclass under the U.S. Patent Classification system and other organized systems of literature, **that may have material pertinent to the subject matter as claimed**. Every subclass, digest and cross reference art collection pertinent to each type of invention claimed should be listed, from the largest combination through the various subcombinations to the most elementary part. **The search should extend to all probable areas relevant** to the claimed subject matter and should cover the disclosed features which might reasonably be expected to be claimed.

The examiner should plan a search that not only covers the claimed subject matter, but one that also covers the disclosed features that might reasonably be expected to be claimed. (emphasis added).

Section 904.02 recites:

It is a prerequisite to a speedy and just determination of the issues involved in the examination of an application that a careful and comprehensive search, commensurate with the limitations

appearing in the most detailed claims in the case, be made in preparing the first action on the merits so that the second action on the merits can be made final or the application allowed with no further searching other than to update the original search. It is normally not enough that references be selected to meet only the terms of the claims alone, especially if only broad claims are presented; **but the search should, insofar as possible, also cover all subject matter which the examiner reasonably anticipates might be incorporated into applicant's amendment.**

It thus results that the examiner finds references that, while not needed for treating the claims, would be useful for forestalling the possible presentation of claims to other subject matter regarded by applicant as his or her invention, and claimable with the subject matter being currently claimed, but shown to be old by these references. (emphasis added).

From the above-quoted guidelines, it is clear that the scope of a proper search includes:

- (1) Classes and subclasses in which the claimed subject matter is classified;
- (2) Classes and subclasses that may have material pertinent to the claimed subject matter; and
- (3) Classes and subclasses containing subject matter present in the disclosure which might reasonably be expected to be claimed during the prosecution; and,
- (4) Classes and subclasses that may contain subject matter disclose material related to features which might reasonably be expected to be claimed.

Therefore, only where inventions are independent and distinct (as defined by the M.P.E.P.) and require nonoverlapping searches, is restriction proper.

The disclosed and claimed apparatus and methods are interrelated and merit patent protection. They are all directed to a common technology, and stem from a set of core inventive concepts. Thus, the examiner will not be unduly

burdened by searching and examining all of the claims presented by Applicant in a single application. The examiner's search will not be narrowed or reduced by compliance with the restriction requirement, since Applicant has clearly manifested his intent to claim each novel and nonobvious aspect of the invention as evidenced by the claims in the application.

The search performed by the examiner will be identical whether the examiner searches respecting the apparatus claims or the method. As such, it would be a total waste of time, money and energy to require the examiner to perform the same search twice. This alone should be sufficient for the examiner to reconsider and withdraw the restriction requirement and to proceed with a meritorious examination of all of the claims pending in the application.

2. Cost To Applicant of the Proposed Restriction Would Be Unduly Burdensome

While the Patent and Trademark has a legitimate interest in obtaining proper revenue from filing and issuance fees, it does not have unrestrained power to tax inventive. Applicant is entitled to obtain patent protection on each of the nonobvious invention aspects of the apparatus and method which applicant has disclosed. If the Applicant, an individual inventor, is forced to divide this application into two separate patent applications as suggested by the examiner, Applicant will be unduly and unfairly burdened with excessive fees and costs associated with prosecuting and maintaining an additional patent.

a) Government Fees Will Nearly Double

If Applicant is forced to divide the present application into two separate patent applications as suggested by the examiner, Applicant will pay a minimum of over \$7,970.00 in government fees to apply for, receive and maintain two separate patents, an increase of over \$3,810.00 over the expected fees for a single application. This additional expense is unreasonably burdensome for an individual inventor for an invention which has yet to be commercialized.

The following Table 1 illustrates the additional official fees which would be generated in the event the 2-way restriction requirement for the instant application is maintained and one (1) divisional application is filed:

TABLE 1

A)	Original non-refundable filing fee (including preliminary amendment)	\$ 370.00
B)	Issue fees	\$ 640.00
C)	Maintenance fees	
	i) 3.5 years	\$ 440.00
	ii) 7.5 years	\$1010.00
	iii) 11.5 years	\$1450.00
D)	Recording assignment	\$ 40.00
TOTAL		\$3950.00

Undoubtedly this will increase in time as the Patent & Trademark Office increases its fees.

3) The Patent Office's First Responsibility Is Public Service, Not Collecting Revenue

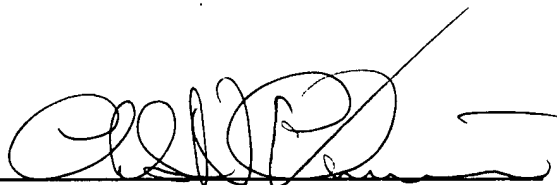
While Applicant recognizes the Patent & Trademark Office's interest in obtaining proper revenue from filing and issuance fees, the Patent & Trademark Office is not in the business of assisting the IRS in reducing the national debt. The sole function of the Patent & Trademark Office is to serve the public in an

efficient and expeditious manner. The Patent & Trademark Office is charged with a duty to carry out its responsibility of examining patent applications in a manner most efficient to the public. Efficient use of administrative resources and expeditious processing of this application will be better served by performing one comprehensive search as contrasted to two separate searches.

IV. CONCLUSION

For all of the foregoing reasons, applicant respectfully submits that the restriction requirement currently in the application is not well-founded and should be withdrawn, with all of the claims pending in the application being examined collectively following a single, comprehensive search of the prior art. Notification that the restriction requirement has been reconsidered and withdrawn is respectfully solicited.

Respectfully submitted,



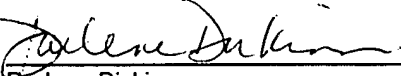
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Darlene Dickinson
February 11, 2002